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92

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/818,992 03/28/2001 Bradford H. Needham P 0275014 P10427 9762

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PILLSBURY WINTHROP LLP
725 S. FIGUEROA STREET
SUITE 2800
LOS ANGELES, CA 90017

EXAMINER

KIM, AHSHIK

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,992

Applicant(s)

NEEDHAM ET AL.

Examiner

Ahshik Kim

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/10/04 (Amendment).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2876

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the amendment filed on December 20, 2003. In the
5 amendment claims 1, 17, 19, 21, 24, 25, 28, 30, 32, and 34 were amended. Currently, claims 1-
35 remain for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
10 obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
such that the subject matter as a whole would have been obvious at the time the invention was made to a person
15 having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the
manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the
claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various
claims was commonly owned at the time any inventions covered therein were made absent any
20 evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out
the inventor and invention dates of each claim that was not commonly owned at the time a later
invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)
and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-2, 5-8, 10-13, 17, 18-27, and 28-35 are rejected under 35 U.S.C. 103(a) as being
25 unpatentable over Tracy et al. (US 5,979,757, hereinafter "Tracy") in view of Sloane et al. (US
6,434,530, hereinafter "Sloane").

Art Unit: 2876

Re claims 1-2, 5-8, 10-13, 17, 19-27, and 28-35, Tracy et al. discloses a system/method a handheld recommendation assistant 70 comprising reading, by a barcode scanner 75 or a RFID tag reader (col. 3, lines 3-1-38), the product information of a product from a product tag (i.e., a UPC code/barcode tag or a RFID tag); retrieving consumer information through a connection
5 (i.e., a connection network/LAN) (col. 9, lines 6-55) to a consumer information storage device (i.e., a database of a remote server or a local database stored on customer's identification card, which can be a smart card (or a floppy disk (col. 13, lines 34+)); acquiring personal information of a user relevant to at least one aspect of the product through an interface on the handheld device (i.e., a touch sensitive display, which serves as an interface for inputting personal
10 information (e.g., password, etc.)), generating a product recommendation related to the product based on at least in part on the personal information and the consumer information (col. 9, lines 55+ and 60+), wherein generating a product recommendation comprising comparing the personal information and the consumer information to produce a comparison result, identifying at least one recommended product whose consumer information is consistent with the personal
15 information, and recommending the at least one recommended product via the display 72 (i.e., price, product name, quantity, recipes, nutritional information and promotion, etc.), wherein the product recommendation is determined by a remote server, which is a central host (col. 14, lines 15+ and lines 60+ and col. 15, lines 34+). See figs. 1-4 and 7A-E; col. 3, lines 30+; col. 4, lines 1-42; col. 5, lines 36+; col. 6, lines 39+ and lines 57+; col. 7, line 34 through col. 11, line 28; and
20 col. 13, lines 34+.

Art Unit: 2876

Although Tracy discloses making product recommendations to the users, Tracy fails to specifically teach or fairly suggest the recommendation is based upon personal and/or product information.

Sloane teaches a mobile shopping assistant (see abstract) which provides production
5 recommendation based on comparing the product info and the customer profile information (col. 7, lines 16-55; col. 13, lines 16-33).

In view of Sloane's teaching, it would have been obvious to an ordinary skill in the art at the time the invention was made to incorporate well-known artificial intelligence to the teachings of Tracy in order to provide customized recommendation to the users. Although simple barcode
10 scanners are still widely used, some shopping assistants are becoming increasingly sophisticated allowing the users to select products which based on personal preferences and needs. Accordingly, implementing recommendation algorithm with primitive artificial intelligence based on customer profile/parameters is well within one ordinary skill in the art could contemplate.

15 Re claim 18, Tracy et al. has been discussed above but fails to teach or fairly suggest the step of storing the product information in a machine readable form in the product tag; and attaching the product tag containing the machine readable product information to the product.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the step of storing the product information in a machine
20 readable form in the product tag and attached the product tag to the product in order to provide Tracy et al. with a faster system wherein the product information can be retrieved readily one the product tag is read by the handheld device, and thus providing a time consuming system.

Art Unit: 2876

Furthermore, such modification would have been an obvious extension as taught by Tracy et al., and therefore an obvious expedient.

5 Claims 3-4, 9, and, 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tracy et al. (US 5,979,757) as modified by Sloanne et al. (US 6,434,53) as applied to claim 1 above, and further in view of Suzuki (US 6,129,274, hereinafter "Suzuki"). The teachings of Tracy as modified by Sloane have been discussed above.

Re claims 3-4, 9, and 13-16: Tracy et al. has been discussed above but fails to teach or fairly suggest that the personal information including tailoring measurements, a color preference.

10 Suzuki teaches the above limitation with the personal information including tailoring measurements, a color preference (col. 4, lines 20+ and col. 10, lines 55+).

In view of Suzuki's disclosure, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of into Suzuki the teachings of Tracy et al. in order to provide the user/customer is provided with a complete recommendation of products that is fit to his/her needs (i.e., his/her desired size and color), and thus providing a more user friendly system. Furthermore, such modification would have been an obvious extension as taught by Tracy et al., and therefore an obvious expedient.

Response to Arguments

6. Applicant's amended claims and remarks filed on June 10, 2004 have been carefully reviewed and considered.

Amended claims are primarily on recommending "a most suitable product equivalent". The amended subject matter was considered, and treated as indicated in paragraph 4

Art Unit: 2876

above. Applicant's arguments with respect to the amended claims further clarifying the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5 Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO
10 MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this
15 final action.

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Lee et al. (US 6,611,814); O'Hagan et al. (US 6,595,417) disclose shopping assistant devices. Applicant is respectfully suggested to carefully review these references.

20 II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (571)272-2393. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571)272-2398. The fax number directly to the
25 Examiner is (571)273-2393. The fax phone number for this Group is (703)872-9306.

Art Unit: 2876

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Ahshik Kim
Patent Examiner
Art Unit 2876
August 27, 2004



KARL D. FRECH
PRIMARY EXAMINER